(36)

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TO: Mr. Jeffrey V. Nase

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VIA FAX TRANSMITTAL

Assistant Commissioner
for Patents
Box Comments
Washington, D.C. 20231

Attention: Mr. Jeffrey V. Nase

Dear Sir:

This letter represents my comments on the proposed rule changes published at 1191 O.G. 105.

I entered into the patent profession in 1989, was an Examiner in Groups 230 and 2500 for approximately 3½ years, and have since been in private practice at the above-captioned firm.

§1.121 MANNER OF MAKING AMENDMENTS

I do not feel that the proposed changes to this rule should be implemented as the proposal would increase the likelihood of prosecution error, create more paper, increase the expense of patent prosecution and patent examining, and increase the cost of storage space.

The proposed changes will require the prosecuting attorney to rewrite all pending claims when an amendment is made. It has been my experience that: (i) innocent errors are much more likely to occur when entire claims are rewritten than when a couple of words are simply added to the original claim; and (ii) the patent examiner will be unduly burdened as he/she will have to compare previous claims and the newly submitted claim to make sure that rewritten claims are correct. Furthermore, such a

requirement would double or triple the length of amendments. Massive file histories are not in the public interest. Creating more and more paperwork, as this rule change would surely do, will do nothing more than increase expense, increase the likelihood of error by both examiners and private practitioners, and increase storage space requirements.

Additionally, innocent errors made in rewriting entire claims will subject innocent attorneys to charges of fraud, inequitable conduct, etc.

Why fix what is not broken?

§1.175 REISSUE OATH

I disagree with the proposed rule change. I have participated in many reissues as both a patent examiner and a private practitioner.

It is in the public interest that the PTO require reissue applicants to explain how supposed "errors" occurred. The courts, as well as the public, are at a disadvantage in reviewing such issues unless reissue applicants are forced, in the PTO, to explain in writing how the errors occurred.

1.53 CONTINUED APPLICANTS

The proposed rule change to the FWC procedure is a good one.

Very truly yours,

Joseph A. Rhoa, Esquire
Reg. No. 37,515

JAR/kn